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206/123
PatentIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Prior Application Serial No. 07/806,929
 Prior Application Filing Date 12/11/91
 Examiner: MARSCHEL, A.
 Art Unit: 1807

REQUEST FORM FOR FILE WRAPPER CONTINUING APPLICATION UNDER 37 CFR § 1.62

Commissioner of Patents and Trademarks
 Washington, DC 20231

This is a request for filing a

Continuation
 Divisional

Application under 37 CFR § 1.62, of prior application Serial No. 07/806,929,
 filed December 11, 1991, of James J. Hogan, et al.,
 for NUCLEIC ACID PROBES FOR DETECTION AND/OR QUANTITATION OF NON-VIRAL
 ORGANISMS

The above-identified prior application in which no payment of the issue fee, abandonment of, or termination of proceedings has occurred, is hereby expressly abandoned as of the filing date of this new application. Please use all the contents of the prior application.

It is understood that secrecy under 35 U.S.C. § 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR § 1.62 application, be it either this application or a prior application in the same file wrapper, the Patent and Trademark Office may provide similar information or access to all other applications in the same file wrapper.

1. Enter the amendment previously filed on 12/22/93 under 37 CFR § 1.116 but unentered, in the prior application.
2. A preliminary amendment is enclosed.

1/ "Express Mail" mailing label number TB230486069 US

Date of Deposit February 22, 1994

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231

Dorothy A. Hook
 (Typed or printed name of person mailing paper or fee)

Dorothy A. Hook
 (Signature of person mailing paper or fee)

3. [] The filing fee is calculated below on the basis of the claims existing in the prior application as amended at 1 and/or 2 above:

For	Number Filed	Number Extra	Rate	Basic Fee
Total Claims Presented			<u> </u> x \$22.00	\$ 0
Independent Claims Presented			<u> </u> x \$74.00	0
Multiple Dependent Claims Presented			+ \$230.00	0
Basic Fee (\$710.00)				0
TOTAL FILING FEE				

4. [X] The Commissioner is hereby authorized to charge any fees under 37 CFR § 1.16 and § 1.17 which may be required by this paper, or credit any overpayment, to Deposit Account No. 12-2475. A triplicate copy of this sheet is enclosed.

[X] 37 C.F.R. 1.16 (filing fees)
[X] 37 C.F.R. 1.16 (presentation of extra claims)

5. [] A verified statement that this filing is by a small entity
[] is attached
[] has been filed in the parent application and such status is still proper and desired (37 CFR 1.28(a))
Filing fee calculation (50% of above) \$ _____

6. [] A check (No. _____) in the amount of \$ _____ is enclosed.

7. [X] Amend the specification by inserting before the first line the sentence: -- This application is a [X] continuation
[] division of application Serial No. 07/806,929, filed December 11, 1991. --

8. [X] The prior application is assigned of record to GEN-PROBE INCORPORATED.

9. [] Also enclosed is _____.

10. [X] The power of attorney in the prior application is to
LYON & LYON, Suite 3400, 611 West Street, Los Angeles, CA 90017

a. [X] The power appears in the original papers in the prior application.

b. [] As the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c. [X] Kindly recognize as associate attorney: Roland N. Smoot, Reg. No. 18,718; Conrad R. Solum, Jr., Reg. No. 20,467; James W. Geriak, Reg. No. 20,233; Robert M. Taylor, Jr., Reg. No. 19,848; Samuel B. Stone, Reg. No. 19,297; Douglas E. Olson, Reg. No. 22,798; Robert E. Lyon, Reg. No. 24,171; Robert C. Weiss, Reg. No. 24,939; William E. Thomson, Jr., Reg. No. 20,719; Richard E. Lyon, Jr., Reg. No. 26,300; John D. McConaghay, Reg. No. 26,773; William C. Steffin, Reg. No. 26,811; Coe A. Bloomberg, Reg. No. 26,605; J. Donald McCarthy, Reg. No. 25,119; John M. Benassi, Reg. No. 27,483; James H. Shaick, Reg. No. 29,749; Allan W. Jansen, Reg. No. 29,395; Robert W. Dickerson, Reg. No. 29,914; Roy L. Anderson, Reg. No. 30,240; David B. Murphy, Reg. No. 31,125; James C. Brooks, Reg. No. 29,898; Jeffrey M. Olson, Reg. No. 30,790; Steven D. Hemminger, Reg. No. 30,755; Jerrold B. Reilly, Reg. No. 32,293; Suzanne L. Biggs, Reg. No. 30,158; and Steven M. Weiss, Reg. No. 37,534 of LYON & LYON, 611 West Sixth Street, Los Angeles, California 90017, Telephone (619) 552-8400.

d. [X] Address all future communications to: Richard J. Warburg, Esq., LYON & LYON, Suite 3400, 611 West Sixth Street, Los Angeles, CA 90017

Date: 2/27/94

Richard J. Warburg, Esq.
Reg. No. 32,327



(Rd. 28-11/85 Pub. 603)

10/454529

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 195/190

Anticipated Classification of this application:

Class 536 Subclass 27

Prior application:

Examiner: Marschel, A.

Art Unit: 187

Commissioner of Patents and Trademarks
Box FWC
Washington, D.C. 20231

FILE WRAPPER CONTINUING APPLICATION (FWC)

WARNING: *This form cannot be used where the parent case may not be abandoned since the filing of a request under the FWC procedure "will be considered to be a request to expressly abandon the prior application as of the filing date granted to the continuing application." 37 CFR 1.62(g).*

WARNING: *This procedure can only be used for a pending application prior to payment of the issue fee. 37 CFR 1.62(a).*

WARNING: *The claims of this new application may be finally rejected in the first Office action where all claims of the new application are drawn to the same invention claimed in the earlier application and would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. MPEP § 706.07(b).*

WARNING: *A continuation-in-part application under 37 CFR 1.62 is filed by making changes by amendment to the prior application, 37 CFR 1.62(a), and not with a new application.*

WARNING: *Filing under 37 CFR 1.62 is permitted only if filed by the same or less than all the inventors, named in the prior application.*

I. This is a request for a filing under the file wrapper continuing application procedure, 37 CFR 1.62, for a

continuation

divisional

continuation-in-part (for oath or declaration see II below)

attached is an amendment for added subject matter of prior complete application Serial No. 07/295,208, filed on 12-09-88

NOTE: *The filing date under 37 CFR 1.62(a) is "The date on which a request is filed for an application... including identification of the Serial Number, filing date and applicant's name of the prior application". According to 37 CFR 1.51(a) a prior complete application comprises: (1) a specification, including a claim or claims, (2) a*

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this FWC transmittal and the documents referred to as attached therein are being deposited with the United States Postal Service on this date ✓ DECEMBER 11, 1991 in an envelope as "Express Mail Post Office to Addressee" mailing Label Number ✓ 68580494765 addressed to the: Commissioner of Patents and Trademarks Washington, D.C. 20231

✓ CARA GRIFFONE

(Type or print name of person mailing paper)

✓ Cara Griffone

(Signature of person mailing paper)

NOTE: *Each paper or fee filed by "Express Mail" has the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 CFR 1.10(b).*

declaration, (3) drawings, when necessary and (4) the prescribed filing fee. Accordingly, as presently worded, 37 CFR 1.62 does not permit the FWC procedure to be used where the prior application is pending but only the processing and retention fee required by 37 CFR 1.21(l) is paid.

(further particulars of prior application are)

1. Title (as originally filed) NUCLEIC ACID PROBES, FOR DETECTION AND/OR
and as last amended) QUANTITATION OF NON-VIRAL ORGANISMS
2. Name of applicant(s) (as originally filed and as last amended) and current correspondence address of applicant(s)

1. FULL NAME OF INVENTOR	FAMILY NAME Hogan	FIRST GIVEN NAME James	SECOND GIVEN NAME John
RESIDENCE & CITIZENSHIP	CITY San Diego	STATE OR FOREIGN COUNTRY CA	COUNTRY OF CITIZENSHIP U.S.A.
POST OFFICE ADDRESS	2727 First Ave	CITY San Diego	STATE & ZIP CODE/ COUNTRY CA 92103
2. FULL NAME OF INVENTOR	FAMILY NAME Smith	FIRST GIVEN NAME Richard	SECOND GIVEN NAME Dana
RESIDENCE & CITIZENSHIP	CITY San Diego	STATE OR FOREIGN COUNTRY CA	COUNTRY OF CITIZENSHIP U.S.A.
POST OFFICE ADDRESS	3522 Mercer Ln.	CITY San Diego	STATE & ZIP CODE/ COUNTRY CA
3. FULL NAME OF INVENTOR	FAMILY NAME Kop	FIRST GIVEN NAME JO	SECOND GIVEN NAME Ann
RESIDENCE & CITIZENSHIP	CITY San Marcos	STATE OR FOREIGN CA	COUNTRY OF CITIZENSHIP U.S.A.
POST OFFICE ADDRESS	1314 Hampton Rd.	CITY San Marcos	STATE & ZIP CODE/ COUNTRY CA 92069

(Add similar information for additional inventors, if applicable)

The above identified application in which no payment of issue fee, abandonment of, or termination of proceedings has occurred, is hereby expressly abandoned as of the filing date of this new application. Please use all the contents of the prior application file wrapper, including the drawings, as the basic papers for the new application.

It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR 1.62 application, be it either this application or a prior application in the same file wrapper, the PTO may provide similar information or access to all the other applications in the same file wrapper.

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declaration, (3) drawings, when necessary and (4) the prescribed filing fee. Accordingly, as presently worded, 37 CFR 1.62 does not permit the FWC procedure to be used where the prior application is pending but only the processing and retention fee required by 37 CFR 1.21(l) is paid.

(further particulars of prior application are)

1. Title (as originally filed) NUCLEIC ACID PROBES FOR DETECTION AND/OR
and as last amended) QUANTITATION OF NON-VIRAL ORGANISMS
2. Name of applicant(s) (as originally filed and as last amended) and current correspondence address of applicant(s)

1. FULL NAME OF INVENTOR	FAMILY NAME McDonough	FIRST GIVEN NAME Sherrol	SECOND GIVEN NAME Hoffa
RESIDENCE & CITIZENSHIP	CITY San Diego	STATE OR FOREIGN COUNTRY CA	COUNTRY OF CITIZENSHIP U.S.A.
POST OFFICE ADDRESS	POST OFFICE ADDRESS 4697 Robbins St.	CITY San Diego	STATE & ZIP CODE/ COUNTRY CA 92122
2. FULL NAME OF INVENTOR	FAMILY NAME	FIRST GIVEN NAME	SECOND GIVEN NAME
RESIDENCE & CITIZENSHIP	CITY	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP
POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE & ZIP CODE/ COUNTRY
3. FULL NAME OF INVENTOR	FAMILY NAME	FIRST GIVEN NAME	SECOND GIVEN NAME
RESIDENCE & CITIZENSHIP	CITY	STATE OR FOREIGN	COUNTRY OF CITIZENSHIP
POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE & ZIP CODE/ COUNTRY

(Add similar information for additional inventors, if applicable)

The above identified application in which no payment of issue fee, abandonment of, or termination of proceedings has occurred, is hereby expressly abandoned as of the filing date of this new application. Please use all the contents of the prior application file wrapper, including the drawings, as the basic papers for the new application.

It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR 1.62 application, be it either this application or a prior application in the same file wrapper, the PTO may provide similar information or access to all the other applications in the same file wrapper.

(FWC [4-2] -page 2A of 8)

II. Inventorship statement

NOTE: "If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application." 37 CFR 1.62(a) [emphasis added].

NOTE: "In the case of a continuation-in-part application which adds and claims additional disclosure by amendment, an oath or declaration as required by §1.63 must be filed. In those situations where a new oath or declaration is required due to additional subject matter being claimed, additional inventors may be named in the continuing application. In a continuation or divisional application which discloses and claims only subject matter disclosed in a prior application, no additional oath or declaration is required and the application must name as inventors the same or less than all the inventors in the prior application." 37 CFR 1.60(c).

(complete applicable item (a), (b) and/or (c) below)

(a) This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

the same

less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

(Type name(s) of inventor(s) to be deleted)

(b) This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application whose particulars are set out above the inventor(s) in this application are

the same

add the following additional inventor(s)

(Type name of inventor(s) to be added)

(c) The inventorship for all the claims in this application are

the same

not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

III. Declaration or oath**A. Continuation or divisional**

none required

B. Continuation-in-part

attached

an original

executed by (check all applicable items)

inventor(s).

legal representative of inventor(s) 37 CFR 1.42 or 1.43.

joint inventor or person showing a proprietary interest for inventor who refused to sign or cannot be reached. 37 CFR 1.47;

This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See item VI below for fee.

not attached

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Application is made by a person authorized under 37 CFR 1.41(c) on behalf of all of the above named applicant(s). The declaration or oath, along with the surcharge required by 37 CFR 1.16(e) can be filed subsequently.

showing that the filing is authorized. (Not required unless called into question. 37 CFR 1.41(d)).

IV. Fee Calculation—Amendments

WARNING: "The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." MPEP, § 706.07(b).

The fees to be charged are to be based on the number of claims remaining as a result of the

attached preliminary amendment

the unentered amendment filed under 37 CFR 1.116 in the prior application, which is now repeated

the claims as on file in the prior application

CLAIMS FOR FEE CALCULATION

	Number Filed	Number Extra	Rate	Basic Fee
				\$630.00
Total Claims	32	12	\$20.00	\$240.00
Independent Claims	6	3	\$60.00 \$34.00	\$180.00
Multiple dependent claim(s), if any			\$200.00	\$200.00

The fee for extra claims is not being paid at this time.

Filing fee calculation
\$ 1,250.00

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 CFR 1.16(d).

V. Small Entity Statement

A verified statement that this is a filing by a small entity is attached.

The small entity statement was filed in the parent application Serial No. _____ on _____ and this status is still proper and its benefit under 37 CFR 1.28(a) is hereby claimed.

Filing fee calculation (50% of above)

S

NOTE: 37 CFR 1.28(a) states "Status as a small entity must be specifically established by a verified statement filed in each application or patent in which the status is available and desired, except those applications filed under § 1.60 or § 1.62 of this part where the status as a small entity has been established in a parent application and is still proper."

(FWC [4-2]—page 4 of 8)

The last sentence of 37 CFR 1.29(a) states: "Applications filed under §1.60 or §1.62 of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired.

Any excess of the full fee paid will be refunded if a verified statement and a refund request are filed within 2 months of the date of timely payment of a full fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

VI. Fee Payment Being Made at This Time

Not attached

No filing fee is submitted. (This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently.)

Attached

filing fee \$ 1,250.00

recording assignment (\$7.00; 37 CFR 1.21(h)(i)).
See item xii below. \$ _____

petition fee for filing by other than all the inventors or person not the inventor where inventor refused to sign or cannot be reached (\$140.00; 37 CFR 1.47 and 1.17(h)) \$ _____

processing and retention fee (\$100.00; 37 CFR 1.53(d) and 1.21(l)) \$ _____

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as, the changes to 37 CFR 1.53 and 1.78 indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee or the processing and retention fee in § 1.21(l) must be paid within 1 year from the notification under § 1.53(d).

Total fees enclosed \$ 1,250.00

VII. Method of Payment of Fees

attached is check in the amount of \$ 1,250.00
 charge Account No. _____ in the amount of \$ _____

A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

VIII. Authorization to Charge Additional Fees

NOTE: If no fee payment is made at this time this item should not be completed.

WARNING: Accurately count claims, especially multiple dependent claims. To avoid unexpected high charges if extra claim charges are authorized.

The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the entire pendency of this application to Account No. 12-2475:

37 CFR 1.16 (filing fees)
 37 CFR 1.16 (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid on these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.17(d)) it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

37 CFR 1.17 (application processing fees)
 37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance, 37 CFR 1.311(b).

From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity. Notification of any change of status resulting in loss of entitlement to small entity status must be filed in the application prior to, or at the time of, paying the issue fee. 37 CFR 1.28(b).

IX. Instructions as to Overpayment

credit Account No. 12-2475
 refund

X. Priority—35 U.S.C. 119

Priority of application Serial No. _____ filed on _____ in _____ is claimed under 35 U.S.C. 119. (country)

The certified copy has been filed in prior U.S. application Serial No. _____ filed _____

certified copy will follow

(FWC [4-2]—page 6 of 8)

XI. Relate Back—35 U.S.C. 120

Amend the specification by inserting before the first line the sentence:

This is a

continuation
 divisional
 continuation-in-part

of co-pending application Serial No. 07/295,208 filed on 12/9/88

XII. Assignment

the prior application is assigned of record to ML TECHNOLOGY VENTURES, L.P.
on January 7, 1988, and subsequently assigned to GEN-PROBE
INCORPORATED on October 15, 1990
 an assignment of the invention to _____

is attached.

XIII. Power of Attorney

The power of attorney in the prior application is to

R. WARBURG

32,327

Attorney

Reg. No.

d. The power appears in the original papers in the prior application.
e. The power does not appear in the original papers, but was filed on 12/10/91
f. A new power has been executed and is attached.
g. Address all future communications to:

Richard J. Warburg, Esq.

32,327

Name

Lyon & Lyon

Reg. No.

Address

34th Floor, 611 W. Sixth St.

(213) 489-1600

Los Angeles, CA 90017

Tel. No.

(Item g may only be completed by applicant, or attorney or agent of record).

XIV. Maintenance of Copendency of Prior Application

(This item must be completed and the papers filed if the period set in the prior application has run)

A petition, fee and response has been filed to extend the term in the pending prior application until _____

XV. Conditional Petitions for Extension of Time in Parent Application

(complete this item if previous item not applicable)

a conditional petition for extension of time is being filed in the pending parent application

XVI. Abandonment of Prior Application

Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

NOTE: According to the Notice of May 13, 1983 (103, THIOG 6-7) the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

December 11, 1991

Date

Lyon & Lyon

P.O. Address of Signatory

34th Floor, 611 W. Sixth St

Los Angeles, CA 90017

Tel. No.: (213) 489-1600

Reg. No. 321327

(if applicable)

Richard J. Warburg

Type or print name of person signing

Signature

Inventor
 Assignee of complete interest
 Person authorized to sign on behalf of assignee
 Attorney or agent of record
 Filed under Rule 34(a)

(Complete the following if applicable)

Type name of assignee

Address of assignee

Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on _____

Reel _____ Frame _____

(FWC [4-2]—page 8 of 8)